

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: PAUL THOMAS WATSON ET AL.)
)
SERIAL NO.: 10/029,172) ART UNIT:
) 2623
FILED: DECEMBER 28, 2001)
) EXAMINER:
FOR: METHODS AND DEVICES FOR DISCOURAGING) HOSSAIN, F. E.
)
UNAUTHORIZED MODIFICATIONS TO SET TOP)
BOXES AND TO GATEWAYS)

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REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

In response to the Final Office Action mailed August 12, 2008, and in conjunction with the concurrently filed Notice of Appeal, Applicants request a pre-Appeal conference in view of the following remarks.

REMARKS

In response to the final Office Action dated August 12, 2008, Applicants respectfully request reconsideration based on the following remarks. Applicants respectfully submit that the pending claims distinguish over the cited documents.

Claims 1-6 and 18-20 were rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement. Claim 1 recites, “a first port coupling a processor to a first communications network and to a database.” The Examiner states that the “STB may be connected to the database in some form based on the connection to the service provider but there is no direct connection to the database with the processor.” Claim 1 does not require a “direct” connection between the processor and the database. Claim 1 recites that the processor is “coupled” to a first communications network and to a database. There is nothing in claim 1 that requires a direct connection between the processor and the database. The term “coupled” is intended to have a broad meaning, including indirect connections through other devices. The Examiner acknowledges that the processor is connected to the database in some form, which is consistent with the term coupled in claim 1. Thus, claims 1-6 satisfy 35 U.S.C. § 112, first paragraph.

The Examiner also based the rejection on the phrase “disable operation of the set top box.” The specification teaches that an operating instruction can include instructions that tell STB 106 to modify, disable, fail to address, or fail to use unauthorized resources (paragraph [0050]). The specification also gives an example of an instruction to disable a 20-gigabyte hard drive in an STB (paragraph [0051]). The phrase “disable operation of the set top box” is supported by the specification, as disabling one or more of the STBs resources (e.g., hard drive) can certainly disable the STB. Applicants would gladly amend claims 1 and 18 to recite “disabling a resource of the set top box” to overcome this rejection.

Claims 1-6 and 18-20 were rejected under 35 U.S.C. § 103(a) as being obvious over Levin in view of Feigen, Gold, Coss, Bruynsteen and Medvinsky. This rejection is traversed for the following reasons.

Claim 1 recites, *inter alia*, “the first port sending resource information associated with the set top box, the resource information describing at least two disk drives and a capacity of each disk drive; . . . the processor receiving an instruction when there is a difference between the capacity of the disk drives and authorized storage for the set top box defined in a

database, the difference indicating unauthorized modifications to the set top box, the instruction causing the processor to disable operation of the set top box.”

Levin teaches a system for remotely increasing capacity of a recording device 101. Storage capacity of the recording device can be increased through a modem 115. There is no teaching of disabling the recording device “when there is a difference between the capacity of the disk drives and authorized storage for the set top box.” Levin is essentially relied upon by the Examiner for teaching remotely altering aspects of an STB.

Feigen teaches remotely detecting system integrity using hash values. In applying the references, Feigen is relied upon as allegedly teaching determining “a difference between the capacity of the disk drives and authorized storage for the set top box defined in a database, the difference indicating unauthorized modifications to the set top box.” Applicants respectfully disagree that Feigen teaches these features. Feigen does not compare individual components, such as storage capacity. Feigen only teaches generating a hash value based on system elements and comparing the hash value to a stored hash value. Feigen can detect when some component has been altered, but cannot compare storage capacity in particular. For at least this reason, the combination of Levin in view of Feigen, Gold, Coss, Bruynsteen and Medvinsky cannot obviate claim 1 as Feigen does not teach determining “a difference between the capacity of the disk drives and authorized storage for the set top box defined in a database, the difference indicating unauthorized modifications to the set top box” as alleged by the Examiner.

Gold was relied upon for teaching two disk drives and a licensed capacity for the disk drives but fails to teach remotely disabling a STB when there is a difference between the capacity of the disk drives and authorized storage for the set top box as recited in claim 1

Coss was relied upon for disclosing aspects of a firewall but also fails to teach remotely disabling a STB when there is a difference between the capacity of the disk drives and authorized storage for the set top box as recited in claim 1.

Bruynsteen was relied upon as allegedly teaching a “processor receiving an instruction when there is a difference between the capacity of the disk drives and authorized storage for the set top box defined in a database, the difference indicating unauthorized modifications to the set top box.” Applicants submit that Bruynsteen fails to teach this feature. Bruynsteen is related to increasing storage capacity of a hard disk drive upon user

request. Bruynsteen makes passing reference to unauthorized tampering in column 4, lines 42-45. This section appears more directed to the physical construction of a controller and read/write unit rather than the “processor receiving an instruction when there is a difference between the capacity of the disk drives and authorized storage for the set top box defined in a database, the difference indicating unauthorized modifications to the set top box” as recited in claim 1. For at least this reason, the combination of Levin in view of Feigen, Gold, Coss, Bruynsteen and Medvinsky cannot obviate claim 1 as Bruynsteen does not teach determining “processor receiving an instruction when there is a difference between the capacity of the disk drives and authorized storage for the set top box defined in a database, the difference indicating unauthorized modifications to the set top box” as alleged by the Examiner.

Medvinsky teaches detecting hacked set top boxes (STBs) by sending a message with an intentional error embedded in the message and detecting the response from the STBs. An STB responding in an unexpected manner is presumed to be hacked and may be disabled (paragraph [0054]). Medvinsky does not teach using a difference between the capacity of a disk drive and authorized storage for the set top box defined in a database as criteria in disabling an STB.

Applicants maintain that none of Levin, Feigen, Gold, Coss, Bruynsteen and Medvinsky teaches using “a difference between the capacity of the disk drives and authorized storage for the set top box defined in a database” as a basis for disabling the set top box. Feigen and Bruynsteen were both relied upon for allegedly teaching this feature. For the reasons above, neither Feigen nor Bruynsteen teaches these features. There is no combination of Levin, Feigen, Gold, Coss, Bruynsteen and Medvinsky that results in the elements of claim 1.

For at least the above reasons, claim 1 is patentable over Levin in view of Feigen, Gold, Coss, Bruynsteen and Medvinsky. Claims 2-6 depend on claim 1 and are patentable over Levin, Feigen, Gold, Coss, Bruynsteen and Medvinsky for at least the same reasons. Claim 18 recites features similar to those discussed above with reference to claim 1 and is patentable over Levin, Feigen, Gold, Coss, Bruynsteen and Medvinsky for at least the same reasons. Claims 19 and 20 depend on claim 18 and are patentable over Levin, Feigen, Gold, Coss, Bruynsteen and Medvinsky for at least the same reasons.

In view of the foregoing remarks and amendments, Applicants submit that the above-identified application is now in condition for allowance. Early notification to this effect is respectfully requested.

If there are any charges with respect to this response or otherwise, please charge them to Deposit Account 06-1130.

Respectfully submitted,

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Date: November 11, 2008